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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,963	06/11/2002	James B. Kargman	991131	8981
34018	7590	06/08/2006	EXAMINER	
GREENBERG TRAURIG, LLP 77 WEST WACKER DRIVE SUITE 2500 CHICAGO, IL 60601-1732			ROSEN, NICHOLAS D	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 06/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Applicant(s)</b>	
	KARGMAN, JAMES B.	
	<b>Application No.</b>	<b>Art Unit</b>
	10/049,963	3625
	<b>Examiner</b>	
	Nicholas D. Rosen	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 March 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 and 8-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-6 and 8-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 June 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

Claims 1-6 and 8-16 have been examined.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over the anonymous article, "Creating Mail Campaigns Straight from Your Desktop," hereinafter "Creating Mail Campaigns," in view of Sparks et al. (U.S. Patent 6,167,382) and Copeland ("New Applications Promote Collaboration on the Web"). As per claim 1, "Creating Mail Campaigns" discloses a method for creating a direct mail advertisement and designating recipients thereof via the Internet, including the step of electronically transmitting data files comprising the design of a direct mail advertisement and the list of recipients toward printing individual copies of the direct mail advertisement to the intended recipients thereof; accepting information for logging a user on to a web site via the Internet (entire article); using the information to identify security rights for the user (implied by the disclosure of logging on to a password-protected area of iMarket's Web site); specifying one or more criteria that define the intended recipient class for the direct mail advertisement; and compiling the list of recipients for the direct mail advertisement corresponding to the specified criteria (entire article). "Creating Mail

Campaigns” does not disclose selecting from one or more pre-defined designs a design for the front side of a direct mail advertisement; selecting a design for the back side of a direct mail advertisement; and specifying the text that appears on the back side of a direct mail advertisement. Sparks, however, teaches selecting from one or more pre-defined designs a design for the front side of an advertisement, selecting a design for the back side of an advertisement, and specifying text for an advertisement (Abstract; column 1, line 66, through column 2, line 48; column 8, line 53, through column 9, line 3; column 10, lines 17-36; column 22, lines 7-56; Figures 55 and 56), and teaches that the finished advertisement may be mailed as direct mail (column 1, lines 42-50). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant’s invention to perform these steps, for the stated advantages of reduced time and cost in developing advertising materials (column 2, lines 12-20 of Sparks).

“Creating Mail Campaigns” does not disclose filtering the list of recipients for the direct mail advertisement as a function of the security rights for the user, but it is well known to filter information as a function of a user’s security rights, as taught by Copeland (paragraph beginning, “IntraActive’s InTandem uses two sets of filters”). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant’s invention to filter the list of recipients for the direct mail advertisement as a function of the security rights for the user, for the obvious advantages, parallel to the advantages expressly disclosed by Copeland, of ensuring that the filtered list of recipients includes only recipients whose information the user is

authorized to see, or recipients whom the user is authorized to contact; and that the filtered list of recipients includes only recipients whose information the user is interested in, or whom the user wishes to contact.

As per claim 2, Sparks discloses selecting from among one or more predefined templates (Abstract, etc.). Hence, this would have been obvious at the time of applicant's invention, for the reasons set forth above in applying Sparks to claim 1.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over "Creating Mail Campaigns," Sparks, and Copeland as applied to claim 1 above, and further in view of Jecha et al. (U.S. Patent 6,631,375). Neither "Creating Mail Campaigns" nor Sparks discloses selecting from among one or more templates uploaded by a user, but Jecha teaches uploading one or more templates from a user (column 4, lines 29-43; column 6, lines 17-30). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to select from among one or more templates uploaded by a user, for the obvious advantage of having the advertisement created in exact accordance with a user's wishes.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over "Creating Mail Campaigns," Sparks, Copeland, and Jecha as applied to claim 3 above, and further in view of Bolnick et al. (U.S. Patent 6,043,817); claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over "Creating Mail Campaigns," Sparks, and Copeland as applied to claim 1 above, and further in view of Bolnick et al. (U.S. Patent 6,043,817). As per claim 4, neither "Creating Mail Campaigns" nor Sparks expressly discloses saving the completed template appearing on the back side of the direct mail

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advertisement for later recall, or as per claim 5, selecting from one or more previously saved templates (at least in the sense of selecting templates previously saved by the client; the templates in Sparks were presumably previously saved by the system proprietor), but it is well known to save one's work, and select from one or more previously saved items, as taught by Bolnick (column 17, lines 15-20). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to save the completed template, as per claim 4, and to select from one or more previously saved templates, as per claim 5, for the obvious advantage of saving time by not having to re-create from scratch the same advertisement, or a quite similar advertisement (involving, e.g., the same place of business, and the same hamburger [as in Sparks], but coupons with different expiration dates).

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over "Creating Mail Campaigns," Sparks, and Copeland as applied to claim 1 above, and further in view of Arledge, Jr. et al. (U.S. Patent 6,535,294). Neither "Creating Mail Campaigns" nor Sparks discloses uploading user supplied artwork and logos for inclusion on the direct mail advertisement, but Arledge teaches uploading user supplied artwork and logos for inclusion in a printed product (column 15, lines 35-44; column 15, line 67, through column 16, line 12). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to upload artwork and logos for inclusion on the direct mail advertisement, even on the back side thereof, for the obvious advantage (see Arledge, columns 3-6) of printing the user's business logos or other artwork on customized printed products.

Claims 8, 9, 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Creating Mail Campaigns," Sparks, and Copeland as applied to claim 1 above, and further in view of the United States Patent and Trademark Office website, <http://www.uspto.gov>, as available in early 1999. As per claim 8, "Creating Mail campaigns" does not expressly disclose that the step of logging into a web site via the Internet further includes the step of identifying the URL used by the user (although the disclosure of a direct marketer logging into a password-protected area of iMarket's web site is suggestive of different direct marketers logging into different password-protected areas customized for them), but it is well known for logging onto a web site to include the step of identifying the URL used by the user, as in the different URL's of the different pages of the U.S.P.T.O. website. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to identify the URL, for the obvious advantage of displaying the appropriate web page.

As per claims 9, 10, and 11, it may be noted from the different webpages of the U.S.P.T.O. website, that the different web pages have different visual appearances, different content, and user selectable different options (such as the option to select one of various web pages linked to the U.S.P.T.O. homepage, the option to search the U.S. Patent database, the option to obtain updated fee information, etc.). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for all of these to have depended on the URL used to log onto the web site.

Claims 12, 13, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Creating Mail Campaigns," Sparks, and Copeland as applied to claim 1 above, and further in view of Galenskaskas ("Targeting and Reaching the Right Customers More Effectively"). As per claim 12, "Creating Mail Campaigns" does not disclose that the step of specifying the one or more criteria comprises specifying a geographic factor in accordance with a map displayed via the web site, but Galenskaskas teaches specifying a geographic factor with map display as one of the criteria defining the recipients of direct mail (sections describing "Tactician Site America" and "E-Z Locate"). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to specify a geographic factor, etc., for the stated advantage of pinpointing an intended audience more precisely, and the obvious advantage of assisting users in understanding matters by graphical display.

As per claim 13, Galenskaskas teaches specifying one or more blocks of addresses in association with mapping (*ibid.*); hence, this is obvious for the reasons set forth in regard to claim 12.

As per claim 16, Copeland teaches excluding information displayed to users as a function of their security rights (paragraph beginning, "IntraActive's InTandem uses two sets of filters"). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to apply this to excluding one or more addresses from one or more blocks of addresses in particular, for the reasons set forth above in the rejection of claim 1.



Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over "Creating Mail Campaigns," Sparks, Copeland, and Galenskias as applied to claim 13 above, and further in view of Sotiroff et al. (U.S. Patent 5,852,810). "Creating Mail Campaigns" does not disclose that specifying the one or more blocks of addresses comprises selecting one or more quadrants set forth in the map displayed via the web site, but it is well known to select one or more quadrants set forth in a map displayed via a web site, as taught by Sotiroff (Abstract; column 5, line 37, through column 6, line 15). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to select one or more quadrants set forth in the map, for the obvious advantages of conveniently locating desired addresses.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over "Creating Mail Campaigns," Sparks, Copeland, and Galenskias as applied to claim 13 above, and further in view of Moore (U.S. Patent 5,452,203). "Creating Mail Campaigns" does not disclose that specifying the one or more blocks of addresses comprises requiring specification of a minimum number of total addresses, but not only are minimum sizes for orders known in general, but Moore teaches that the U.S. Postal Service offers a monetary incentive for mailers who include the correct zip-plus-four code on each letter mailpiece of a predetermined minimum number of mailpieces (column 1, lines 21-33). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention specify a minimum number of total addresses, for the obvious advantage of qualifying for such a bulk mailing discount.

***Response to Arguments***

Applicant's arguments filed March 27, 2006, have been fully considered but they are not persuasive. Furthermore, they are in part mooted by the new art applied in response to Applicant's amendments and traversal of official notice. Examiner has made art explicitly of record to establish the facts of which official notice was taken in the prior Office action. In particular, the article "Creating Mail Campaigns," made of record in response to applicant's amendments and traversals, discloses a marketer logging onto a password-protected area of a Web site used to send direct mail, so the argument that proper motivation is lacking to combine the teaching of Scott with the noticed fact that it is well known to identify a user and establish his security rights is much less applicable.

The Manual of Patent Examination Procedure (2144.03 (C)) states, in regard to traversal of Official Notice:

C. If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding with Adequate Evidence.

To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also Chevenard, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of any demand by appellant for the examiner to produce authority for his

statement, we will not consider this contention.”). A general allegation that the claims define a patentable invention without reference to the examiner’s assertion of official notice would be inadequate.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant’s disclosure. Shane (U.S. Patent 5,793,972) discloses a system and method providing an interactive response to direct mail by creating personalized web pages based on the URL provided on mail pieces. Pintsov et al. (U.S. Patent 5,936,865) disclose a mail processing system with unique mailpiece authorization assigned in advance of mailpieces entering carrier service mail processing stream.

Suganuma et al. (Japanese Patent Application Publication 10-222522-A) disclose an information offer system, information providing device, and direct mail.

The anonymous abstract, “Cluster Systems Help Marketers Identify Geographic Areas That Contain Groups of Consumers Who Share Demographic and Behavioral Characteristics,” discloses various uses for cluster demographics. Roush (“Growing without Pain: Exec Faces Competing Needs”) discloses, inter alia, setting a minimum sized order. Ginsburg (“Mining the SQL Treasure Trove”) discloses identifying users by username and password, and setting filters to limit the information available to them, in accordance with their user class. Alexander (“Milking the Most from the Internet”) discloses direct mail campaigns created online. Linthicum, (“Site Building”) discloses

delivering personalized content to site visitors, and providing authorized users with access to specific restricted areas on the website, based on their profiles.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen whose telephone number is 571-272-6762. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's current acting supervisor, Robert Pond, can be reached at 571-272-6760. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Non-official/draft communications can be faxed to the examiner at 571-273-6762, or emailed to Nicholas.Rosen@USPTO.gov.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*Nicholas D. Rosen*

**NICHOLAS D. ROSEN**  
**PRIMARY EXAMINER**

June 3, 2006